

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Nathaniel P. Langford

Appeal No. 2003-0188
Application No. 09/781,386

ON BRIEF

Before WARREN, JEFFREY T. SMITH and POTEATE, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals the decision of the Primary Examiner finally rejecting claims 21, 24 to 30 and 33 to 36.¹ We have jurisdiction under 35 U.S.C. § 134.

¹ In rendering our decision, we have considered Appellant's arguments presented in the Brief, filed January 29, 2002 and the Reply Brief filed July 9, 2002. We have considered the Examiner's position presented in the Answer, mailed May 8, 2002.

BACKGROUND

Appellant's invention relates to a method for reducing the quantity of dust generated while sanding a hardened joint compound composition by mixing a dust reducing additive prior to applying the joint compound to the wall surface. Claim 21, which is representative of the claimed invention, appears below:

21. A method of reducing the quantity of dust generated while sanding or abrading a hardened drywall joint compound including a filler and a binder comprising the steps of mixing a dust reducing additive with the joint compound prior to applying the joint compound to a wall surface.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Smith et al. (Smith)	4,286,995	Sep. 01, 1981
Williams	4,454,267	Jun. 12, 1984
Struss et al. (Struss)	4,686,253	Aug. 11, 1987
Patel	5,653,797	Aug. 05, 1997

The Examiner has rejected claims 24, 25 and 28 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Williams or Struss; claims 21, 26, 27 and 34 to 36 as unpatentable under 35 U.S.C. § 103(a) as obvious over Williams or Struss; claims 21, 29, 30, 33, 35 and 36 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35

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U.S.C. § 103(a) over Patel; and claims 21, 29, 30 and 34 to 36 17-18 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Smith. (Examiner's Answer, pp. 3 to 7).

Appellant states that “[c]laims 24 and 28 stand or fall together, claims 33 and 34 stand or fall together, and claims 21, 25, 26, 27, 29, 30, 35 and 36 stand or fall by themselves.” (Brief, p. 6).² Appellant's grouping of the claims does not comply with 37 CFR § 1.192 (c)(7)(2001).³ We will consider the claims separately only to the extent that separate arguments are of record in this appeal. *See In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (“If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.”).

²Appellant attempts to withdraw this statement on pages 2 and 3 of the Reply Brief. However, pursuant to the provisions of 37 CFR § 1.192(c)(7)(8)(2001), a statement of the grouping of the claims must be present in the Brief filed within two months from the date of the Notice of Appeal, i.e., the principal Brief (see 37 CFR § 1.192(a) (2001)). Therefore we only consider Appellant's original statement regarding the grouping of claims.

³ Appellant's proposed groups are not exclusive. Claims 33 and 34 are not subject to the same rejections.

DISCUSSION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellant in support of their respective positions.

Rather than reiterate the respective positions advanced by the Examiner and Appellant, we refer to the Examiner's Answer and to Appellant's Briefs for a complete exposition thereof.

The rejection of claims 24, 25 and 28 over the Williams and Struss references

The Examiner has rejected claims 24, 25 and 28 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Williams or Struss. The subject matter of claims 24, 25 and 28 is directed to a method of filling joints between adjacent wallboards that comprises providing a drywall joint compound, applying the joint compound to the joint, allowing the joint compound to harden to a sandable condition and sanding the joint compound to a smooth finish. The Examiner has determined that both Williams and Struss describes a process that performs the above method steps. (Brief, pp. 3-4). The Appellant does not dispute the references describe these process steps. (See Briefs in their entirety). The argued distinction between the claimed invention and the invention of Williams and Struss is the composition of the joint compound. Specifically, Appellant argues the

Examiner has not identified the dust reducing additive contained in the joint compound. (Brief, pp. 8 and 9). Appellant also argues that it would not have been known that adding a wetting agent to the compound of Williams or Struss would provide dust reducing effect. (Brief, pp. 10 and 11).

We are not persuaded by Appellant's arguments. Appellant in the specification discloses the categories of ingredients that can function as a dust reducing additive and the manner by which suppression occurs. Specifically the specification discloses "[i]t is desirable that the dust reducing additive serve to suppress the formation of airborne particles without significantly interfering with the desired characteristics of the joint compound. Suitable dust reducing additives include oils, such as mineral oils, vegetable oils and animal oils, surfactants, oleoresinous mixtures, pitch, solvents, paraffins, waxes, including natural and synthetic wax, glycol, and other petroleum derivatives. Other materials which do not fit within the above categories may also effectively reduce the quantity of dust generated by a joint compound." (Specification, pages 4-5). "It has also been found that increasing the level of resin in the joint compound may serve to reduce the level of airborne dust generated during sanding." (Specification, p. 8). The specification further discloses that the invention is not limited to a particular mechanism for dust reduction. (Specification, p. 8).

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The Examiner has found that Williams and Struss disclose the joint compound comprises a wetting agent (surfactant). (Answer, pp. 3-4). Anticipation under § 102 requires that the identical invention that is claimed was previously known to others and thus is not new. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991); *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777-78 (Fed. Cir. 1985); *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). A person of ordinary skill in the art would have known that a wetting agent (surfactant) was a suitable component for the joint compound composition described in both Williams and Struss. Thus, a person of ordinary skill in the art performing the process of Williams and/or Struss and employing a wetting agent (surfactant) as described therein would have practiced the claimed invention. *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1366, 52 USPQ2d 1303, 1307 (Fed. Cir. 1999) (“Where, as here, the result is a necessary consequence of what was deliberately intended, it is of no import that the article’s authors did not appreciate the results.”); *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) (“It is a general rule that merely discovering and claiming a new benefit of an old

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process cannot render the process again patentable.”); *accord In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The rejection of claims 21, 26, 27 and 34-36 over the Williams and Struss references

The Examiner has rejected claims 21, 26, 27 and 34 to 36 as unpatentable under 35 U.S.C. § 103(a) as obvious over Williams or Struss.

Appellant argues that claim 21 is patentable for the same reasons as claims 24, 25 and 26 and that Williams and Struss fail to disclose any method of reducing dust by any means.

We affirm the rejection for the reasons stated above. In addition, the claimed method is achieved by the presence of a dust reducing additive i.e., wetting agent, in the joint compound. As stated above, Williams and Struss disclose the claimed method and suggest using a wetting agent in their joint compound compositions.

Appellant argues that Williams and Struss do not disclose that the dust reducing additive is present in an amount sufficient to achieve the level of dust reduction as defined in claims 26, 27 and 34-36 (Brief, pp. 13-14).

The Examiner has found the joint compound of Williams and Struss includes a wetting agent (surfactant) and a person of ordinary skill in the art performing the process

of Williams and/or Struss would have been practicing the claimed invention. (Answer, pp. 3-4). Accordingly, we determine that the Examiner has met the initial burden of establishing a *prima facie* case of unpatentability under sections 102 and 103.

Therefore, the burden has been shifted to Appellant to show that the claimed process differs **substantially** from the process disclosed by Williams and Struss. *See Spada*, 911 F.2d at 708, 15 USPQ2d at 1657-58; cf. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). Appellant has not submitted any evidence that the process of Williams and Struss is substantially different than the claimed invention.

The rejection of claims 21, 29, 30, 33, 35 and 36 over the Patel reference

The Examiner has rejected claims 21, 29, 30, 33, 35 and 36 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Patel. According to the Examiner, Patel teaches the claimed process that includes joint compound compositions that comprise dust reducing additives. (Answer, p. 5). According to the Examiner, Patel includes a vegetable oil compound defoamer (Nopco 9201) that meets the dust reducing additive of the claimed invention.⁴ Appellant has not disputed the Examiner's position that the described defoamer of Patel is a vegetable oil compound.

⁴ The Examiner relies on the Smith reference to provide the disclosure that Nopco 9201 is a vegetable oil compound.

Appellant argues that Patel does not anticipate the invention of claim 21 because Patel is directed to a ready mixed setting-type joint compound and makes no mention of dust reduction. (Brief, p. 15).

We are not persuaded by Appellant's argument. Patel discloses the process of applying joint compound to a substrate, allowing it to dry and sanding the dried composition. (Col. 1-2). Example III describes the use of a defoamer and a glycol which, according to Appellant's specification page 8, meet the requirements for dust reducing additives. Thus, a person of ordinary skill in the art performing the process of Patel and employing the composition as described in Example III would have been practicing the claimed invention.

Appellant's arguments regarding claims 29, 30, 33, 35 and 36 are not convincing for the reasons provide by the Examiner in the Answer (pages 11-12). In addition, a person of ordinary skill in the art who performed the process of Patel employing the joint compound compositions described in the examples would have met the requirements of the argued claims.

The rejection of claims 21, 29, 30 and 34-36 over the Smith reference

The Examiner has rejected claims 21, 29, 30, 33, 35 and 36 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Smith. According to the Examiner, Smith teaches the claimed process that includes joint compound compositions that comprise dust reducing additives. (Answer, p. 6). According to the Examiner, Smith includes a vegetable oil compound and propylene glycol that meet the dust reducing additive of the claimed invention.

Appellant argues that Smith does not anticipate the claimed invention because the disclosure by the reference is “purely accidental” and there is no evidence that Smith added the defoamer to reduce dust. (Brief, p. 17).

We are not persuaded by Appellant’s argument. Smith describes the use of a defoamer and a glycol which, according to Appellant’s specification page 8, meet the requirements for dust reducing additives. Smith also discloses the dried joint compound including a defoamer resists cracks. (Col. 2). A person of ordinary skill in the art using a joint compound composition, as described in Smith, in the standard application process, i.e., applying, drying and sanding, would have been practicing the claimed invention. The result achieved (dust reduction) would have been a necessary consequence of what

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was deliberately intended, it is of no import that there was no appreciation of the results. *Mehl/Biophile Int'l Corp.*, 192 F.3d at 1366, 52 USPQ2d at 1307; *Woodruff*, 919 F.2d at 1578, 16 USPQ2d at 1936.

Appellant argues that the “present invention provides a method of reducing the quantity of dust generated by joint compounds such as those disclosed by Patel and Smith et al. by adding to the complete and functional joint compounds a dust reducing additive.” (Brief, p. 18).

The claims are not limited to the scope of Appellant’s argument. The claimed invention does not require the modification of a complete and functional joint compound composition by the addition of a dust reducing additive. The claimed process only requires providing a joint compound composition including a dust reducing additive. The claims that specify adding a dust reducing additive to a joint compound composition does not specify that the additive is not included in the original joint compound formulation.

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CONCLUSION

The rejection of claims 24, 25 and 28 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Williams or Struss; claims 21, 26, 27 and 34 to 36 as unpatentable under 35 U.S.C. § 103(a) as anticipated over Williams or Struss; claims 21, 29, 30, 33, 35 and 36 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Patel; and claims 21, 29, 30 and 34 to 36 17-18 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Smith are affirmed.

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Time for taking action

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHARLES F. WARREN
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

LINDA R. POTEATE
Administrative Patent Judge

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